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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,978	02/06/2002	Eric E. Swayze	IBIS-0403	1815
34138	7590	01/26/2006	EXAMINER	
COZEN O'CONNOR, P.C.			HABTE, KAHSAY	
1900 MARKET STREET			ART UNIT	
PHILADELPHIA, PA 19103-3508			PAPER NUMBER	
			1624	
DATE MAILED: 01/26/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/071,978

Applicant(s)

SWAYZE ET AL.

Examiner

Kahsay Habte

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-21,63 and 65-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63 and 65-72 is/are rejected.
- 7) ☒ Claim(s) 1 and 3-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1, 3-21, 63 and 65-72 are pending in this application.

### ***Response to Amendment***

2. Applicant's amendment filed 12/19/2005 in response to the previous Office Action (8/18/2005) is acknowledged. Rejection of claims 1, 3-21, 63-94 and 96-97 under 35 U.S.C. § 112, second paragraph (Paper No. 3, paragraphs 7a and 7c) and the prior art rejection under 102(b) have been obviated. The second paragraph rejection (item 7b) has been maintained.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: In claim 1, the phrase "\_\_\_\_R<sub>1</sub> is alkyl" is objected because of the lines " \_\_\_\_" in front of variable R<sub>1</sub>. Note that there are total of 9 lines in claim 1. Note that there is the same problem in claim 63. It is recommended that applicants delete the presence of lines from claims 1 and claim 63.

Applicants are also recommended to delete the correct a typographical error in claim 63. The phrase "z is\_1 to 6" should read as "z is 1 to 6".

Claims 3-17 and 19-21 are also objected to of being dependent upon claim 1.

4. In claim 63 (line 6), it is recommended that applicants delete the term "can" from the phrase "R'<sub>15</sub> and R'<sub>16</sub> together with the nitrogen atom to which they are attached **can**

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form a succinimido or phthalimido group". Since the only choice for variables R'<sub>15</sub> and R'<sub>16</sub> is to form a succinimido or phthalimido group, the claim should read as "R'<sub>15</sub> and R'<sub>16</sub> together with the nitrogen atom to which they are attached form a succinimido or phthalimido group".

5. Claim 18 is objected because it has two periods. At page 8, applicants delete the chemical structures but forgot to delete the period at the end of deleted chemical structures.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 63 and 65-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 63, the phrase "a fused ring derivative" is indefinite. What is covered and what is not?

### ***Response to arguments***

Applicant's argument filed 12/19/2005 has been fully considered but it is not persuasive.

Applicants argue: "Applicants respectfully disagree that this term is indefinite, as it is clearly defined in the specification at p.21, line 32 through p.22, line 3. It is well

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established that an applicant may be his or her own lexicographer in defining claim terms...". The examiner disagrees with applicant's argument. The issue is not whether or not an applicant may be his or her own lexicographer, but whether "a fused ring derivative" is indefinite or not. In the specification at p.21, line 32 through p.22, line 3, there is no sufficient guidance for one skilled in the art to understand the metes and bound of said phrase. Can the ring be fused to morpholino? Thiazino? Anthraceno? What is the size of the ring? What is the nature of the ring? Nature of the heteroatoms in the fused ring? Applicants have some examples in the specification, but these examples are benzofused rings (e.g. benzopyrrolidinyl, N- phthalimidyl) or unfused rings (e.g. N-succinimidyl) and do not fully represent "fused ring derivative" ring system.

Note that the term "derivative" is also indefinite. What derivative? Applicants can overcome this rejection by reciting specific rings from the specification (page 22) or delete the phrase "fused ring derivative" from claim 63.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte  
Primary Examiner  
Art Unit 1624

January 23, 2006